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PATENT

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Applicants: Meng *et al.*

Serial No.: 09/815,262 Art Unit: 1623

Filed: March 21, 2001 Examiner: P. Lewis

For: Thioketals and Thioethers for Inhibiting the Expression of VCAM-1

Commissioner for Patents
Washington, D.C. 20231

ELECTION UNDER RESTRICTION REQUIREMENT

Sir:

In an Office Action mailed July 15, 2002, the Examiner restricted the application and has required an election between the following groups:

I. Claims 1-23 and 28-35, drawn to a compound of formula (I), classified in class 536, subclass 1.1.

II. Claims 24-27, drawn to a compound of formula (II), classified in class 585, subclass 24.

III. Claims 36-38, 40-42, 44-50, 52-54, 56-58, 64-66, and 68-70, drawn to a method for treating a disease or disorder mediated by VCAM-1 comprising administering an effect amount of compound of formula (I), classified in class 514, subclass 23.

IV. Claims 39, 43, 51, 55, 59, 6, and 71, drawn to a method for treating a disease or disorder mediated by VCAM-1 comprising administering an effect amount of compound of formula (II), classified in class 514, subclass 762.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on August 15, 2002.

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V. Claims 60-62, drawn to a method for treating hypercholesterolemia or hyperlipidemia comprising administering an effect amount of compound of formula (I), classified in class 514, subclass 23.

VI. Claim 63, drawn to a method for treating hypercholesterolemia or hyperlipidemia comprising administering an effect amount of compound of formula (II), classified in class 514, subclass 762.

Applicants provisionally elect Group I, Claims 1-23 and 28-35, with traverse. Applicants request that the restriction requirement be reconsidered because the Examiner has not shown that a serious burden would be required to examine all the claims. M.P.E.P. § 803 provides:

> If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without serious burden. *See* M.P.E.P. § 803.

The Examiner has not shown that the ***second*** requirement has been met. Specifically, the Examiner has not shown that it would be a serious burden to search and examine groups I, III, and V, or II, IV, and VI, together. Groups I, III, and V all pertain to a specific class of chemical compounds within the genus of formula (I), and to methods of using such compounds in the treatment of various diseases. Similarly, Groups II, IV, and VI all pertain to a specific class of chemical compounds within the genus of formula (II), and to methods of using such compounds in the treatment of various diseases.

Under the holding of In re Ochai, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), if the compounds of formula (I) or (II) are patentable then their use is also patentable, and the Examiner incurs no burden to examine the method of use claims beyond examining the patentability of the compounds of formula (I) and (II). Therefore, the Examiner cannot demonstrate an unreasonable burden sufficient to enter a six way restriction requirement unless he first determines that the compounds of formula (I) or (II) are not patentable. If the Examiner stands by the six way restriction requirement, then Applicants respectfully reserve the right to

represent claims within the scope of Groups III and V upon notice that compounds within the scope of formula (I) as defined by Group I are patentable.

Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

In paragraph 10, the Restriction Requirement further requires Applicant to elect for prosecution a species selected from carbohydrates and non-carbohydrates. Applicants assume that the Examiner does not mean to require Applicant to elect a particular chemical compound within one of these species, and elects to prosecute the non-carbohydrate species. Claims 1, 2, 6-21, 23, 28, 30-32, and 35 read upon this species.

Applicants await an action on the merits.

No fee is believed due. However, the Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 11-0980.

Respectfully submitted,

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